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**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/054,602    04/03/98    SMITH    D    74311ACFR

IM62/0411

EXAMINER

REDDICK, M

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ART UNIT

PAPER NUMBER

1713

DATE MAILED: 04/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/054,602

Applicant(s)  
SMITH ET AL

Examiner  
Judy M. Reddick

Group Art Unit  
1713



☒ Responsive to communication(s) filed on Jan 10, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5 and 11-23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-5 and 11-23 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1713

### DETAILED ACTION

1. Applicants are herein apprised that newly added claims 6-18 have been renumbered as claims 11-23 via Rule 126.
2. Applicants should note and rectify, using cautionary measures, the following discrepancies appearing in the claims.

In claim 5, line 2, "salts" should read "salt" so as to engender claim language consistency.

In claim 16(renumbered), line 2, "stabilizer" should be inserted after "particulate" so as to engender claim language clarity and consistency.

In claim 23(renumbered), line 10, "stabilizer" should be inserted after "particulate".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13, 15 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A) The recited "vinyl" per claims 13 and 22 constitutes indefinite subject matter as per it not being readily ascertainable as to how such differentiates over the other vinyl monomers.
- B) The recited "water-insoluble particulate stabilizer is selected from insoluble metal salts, insoluble metal oxides, oxide, ---" per claims 15 and 22 constitutes indefinite subject matter as per
  - a) the use of improper Markush Language, "selected from the group consisting of" is proper and

Art Unit: 1713

is recommended and b) it is not readily ascertainable as to how the recited "oxide" differentiates over the recited "insoluble metal oxides".

C) The recited "resinous polymers" per claims 15 and 22 constitutes indefinite subject matter as per said terminology engendering redundant subject matter.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 and 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNeil.

McNeil as discussed in the previous Office Action (paper no. 4, 09/24/99, paragraph no. 7). Further, the disclosure of McNeil differs basically from the claimed invention as per the non-specific disclosure of an embodiment directed to the specifically claimed carboxylic acid containing monomer system. However, McNeil teaches that from about 1 to 99 weight percent of vinyl monomer(s) which includes monocarboxylic acids is/are selectively operable within the processes of the disclosed invention (see, col. 11, lines 46+). To this end, it would have been obvious to the skilled artisan to extrapolate carboxylic acid containing monomer for use in the processes of McNeil as per such having been within the purview of the general disclosure of

Art Unit: 1713

patentee and with a reasonable expectation of success. While Patentee does not expressly recognize the use of the specifically claimed promoters and inhibitors, such are considered conventional recipe ingredients in polymerization processes, as disclosed. Finally, the interchangeability of one well known salt for another is a matter of ordinary choice to the skilled artisan absent some evidence of unusual or unexpected results.

*Response to Arguments*

6. Applicant's arguments filed January 10, 2000 have been fully considered but they are not persuasive.

While Counsel argues that there is really no suggestion to use a combination of monomers as claimed and the only mention of carboxylic acid containing monomer is at col. 11, lines 46+, Counsel is reminded that a reference is evaluated as a whole for what it fairly teaches and in no way limited to the working Runs and to this end, McNeil clearly provides ample guidelines to use mixtures of those monomers disclosed at col. 11 which include carboxylic acid containing monomers. Criticality for such, not having been demonstrated on this record. The generic inorganic pigment is a necessary implication that any inorganic pigment, including the claimed inorganic compound, would have been operable within the scope of patentees invention and with a reasonable expectation of success. There is nothing iron clad on this record diffusing this issue.

7. After further consideration coupled with Counsel's persuasive arguments, the rejection based on Stamberger is herein withdrawn.

Art Unit: 1713

**Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703) 308-4346.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-3885.

JMR *JMR*

*J. M. Reddick*  
Judy M. Reddick

04/06/00

Primary Examiner

Art Unit 1713